



PATENT
Customer No. 22,852
Attorney Docket No. 6832.0064

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Craig A. Rosen et al.) Group Art Unit: 1653
)
Application No.: 10/775,180) Examiner: Karen C. Carlson, Ph.D.
)
Filed: February 11, 2004) **Allowed: May 23, 2006**
)
For: ALBUMIN FUSION PROTEINS) Confirmation No.: 1800

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

COMMENTS ON STATEMENT IN NOTICE OF ALLOWABILITY

Applicants submit the following comments in response to the Examiner's Amendment/Comment and Statement of Reasons for Allowance attached to the Notice of Allowability dated May 23, 2006. The Office stated on page 2 of the Examiner's Statement that:

The Office is in receipt of the Reply to Requirement for Information under 37 CFR 1.105 filed March 31, 2006. The Examiner appreciates Applicant's representative pointing out references relevant to the instant invention for a method of treating obesity or reducing weight using fusion proteins comprising tandem GLP-1 polypeptides and albumin. These references have been initialed on the five submitted IDS PTO-1449s, while those references not relevant to the invention have been lined through.

The Requirement for Information under Rule 1.105 required Applicants to "state which references [submitted in IDSs] are *specifically relevant* to the claimed invention." (Emphasis added). The Rule 1.105 Requirement did not define what the

Office believed to be specifically relevant and it did not require Applicants to distinguish between relevant and irrelevant art. Nevertheless, in good faith and in satisfaction of the duty of candor under 37 C.F.R. § 1.56 to reply to a requirement under 37 C.F.R. § 1.105 with information reasonably and readily available, Applicants replied to the Requirement on March 31, 2006, providing a list of references that relate generally to albumin fusion protein technology, to GLP-1 polypeptides and to treatment of obesity with GLP-1. Applicants did not assert that the references not listed in the Reply to the Rule 1.105 Requirement are not relevant.

In further satisfaction of the duty of candor and good faith under 37 C.F.R. § 1.56, Applicants had submitted references to be considered by the Office in properly filed Information Disclosure Statements. However, the Office improperly failed to consider all of the references. All of the Information Disclosure Statements submitted by Applicants complied with 37 C.F.R. §§ 1.97 and 1.98, and the Office never asserted that they did not comply with the regulations. The Office cannot refuse to consider the references simply because they are too voluminous. Because all of the Information Disclosure Statements and accompanying PTO/SB/08 forms complied with the provisions of 37 C.F.R. §§ 1.97 and 1.98, the Office should have considered all of the references properly submitted by Applicants. However, even though the Office failed to consider the submitted references, Applicants assert that they have satisfied their duty of disclosure and candor by properly submitting the references in full compliance with 37 C.F.R. §§ 1.97 and 1.98.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 25, 2006

By: Charles E Van Horn
Charles E. Van Horn
Reg. No. 40,266